

**IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS  
WACO DIVISION**

NCS MULTISTAGE INC.,

Plaintiff,

vs.

NINE ENERGY SERVICE, INC.,

Defendant.

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CIVIL ACTION NO. 6:20-cv-00277-ADA

**PLAINTIFF NCS’S OPPOSED MOTION TO STRIKE DEFENDANT NINE  
ENERGY SERVICE INC.’S PRELIMINARY INVALIDITY CONTENTIONS**

Plaintiff NCS Multistage Inc. (“NCS”) hereby moves to strike Defendant Nine Energy Inc.’s (“Nine”) Preliminary Invalidity Contentions for failing to provide NCS any notice of Nine’s invalidity theories.

Pursuant to the Court’s Order Governing Proceedings—Patent Cases, Nine was required to serve Preliminary Invalidity Contentions “in the form of (1) a chart setting forth where in the prior art references each element of the asserted claim(s) are found...” Dkt. 20. The purpose of infringement and invalidity contentions are to provide notice of a party’s theories, requiring “parties to crystallize their theories of the case early in the litigation so as to prevent the ‘shifting sands’ approach to claim construction.” *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, No. 2:14-cv-911, 2016 U.S. Dist. LEXIS 191646, at \*9 (E.D. Tex. March 21, 2016) (quoting *Keranos, LLC v. Silicon Storage Tech., Inc.*, 797 F.3d 1025, 1035 (Fed. Cir. 2015); *Pisony v. Commando Constrs., Inc.*, No. 6:17-cv-55, 2020 U.S. Dist. LEXIS 153007, at \*4-5 (W.D. Tex. Aug. 24, 2020).

On September 11, 2020, Nine served its Preliminary Invalidity Contentions in the form of the chart attached hereto as **Exhibit A**, where it identified over 50 references and numerous

citations for each reference. There is not a single explanation in the contentions of which references are anticipating or obvious, and Nine did not identify a single combination of references. Instead, each claim limitation has dozens of prior art citations with thousands of possible combinations. NCS has no notice of Nine's invalidity theories as this case moves into the claim construction schedule on September 25, 2020.<sup>1</sup>

In a meet and confer, Nine's counsel stated that Nine has complied with the Court's Order and that this Court did not adopt the EDTX or SDTX local patent rules that require more detailed contentions. While Nine may be hiding behind the literal words of this Court's order—"a chart setting forth where in the prior art references each element of the asserted claim(s) are found"—NCS does not believe a chart with thousands of possible prior art combinations and no other information is what the Court intended in its Order, and it is certainly not within the spirit of the notice function of invalidity contentions. Nine's counsel knows full well what invalidity contentions should include and their purpose, and that is obvious by its reference to the EDTX and SDTX local patent rules. It appears that Nine's claim chart is no more than a prior art dump, designed to ratchet up NCS's costs. *Pers. Audio, LLC v. Togi Entm't, Inc.*, 2:13-cv-13, 2014 U.S. Dist. LEXIS 194378, at \*6-7 (E.D. Tex. Aug. 5, 2014) (striking invalidity contentions where defendant dumped numerous references in its invalidity contentions and only identified a few exemplary combinations from a universe of thousands of possible combinations).

For the foregoing reasons, NCS respectfully asks the Court to strike Nine's Preliminary Invalidity Contentions and order Nine to re-serve preliminary invalidity contentions.

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<sup>1</sup> The parties are to exchange terms for construction on September 25, 2020. Dkt. 25 at 2. Opening claim construction briefs are due on October 30, 2020. *Id.*

Dated: September 16, 2020

Respectfully submitted,

BLANK ROME LLP

/s/ Domingo M. Llagostera

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**ATTORNEYS FOR PLAINTIFF NCS  
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**CERTIFICATE OF SERVICE**

The undersigned certifies that all counsel of record were electronically served with a copy of the foregoing on September 16, 2020 via the Court's CM/ECF system.

/s/ Domingo M. Llagostera

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